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OFFICE OF PETITIONS

In re Application of :
Joseph E. Porcelli :
Application No. 09/356,771 : DECISION ON PETITION
Filed: July 16, 1999 : UNDER 37 C.F.R. §1.137(a)
Attorney Docket Number: 1310-2 :
Title: CAR AND TRUCK BEVERAGE :
HOLDER :

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(a)¹, to revive the above-identified application, filed on March 8, 2007.

The concurrently submitted change of correspondence address has been entered and made of record.

¹ A grantable petition pursuant to 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. §1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. §1.20(d)) required pursuant to paragraph (d) of this section.

THE RELEVANT STANDARD

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."²

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"³

Nonawareness of a PTO rule will not constitute unavoidable delay⁴

The burden of showing the cause of the delay is on the person seeking to revive the application⁵.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action⁶.

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business⁷.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."⁸ Nonetheless, a petition cannot be granted where a petitioner has failed to meet

2 Id.

3 See In re Mattullah, 38 App. D.C. 497 (D.C. Cir. 1912).

4 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

5 Id.

6 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

7 In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

8 Smith v. Mossinghoff, 671 F.2d at 538, 213 U.S.P.Q. at 982.

his or her burden of establishing that the delay was
"unavoidable."⁹

THE COMMISSIONER IS RESPONSIBLE FOR DETERMINING THE STANDARD FOR
UNAVOIDABLE DELAY AND FOR APPLYING THAT STANDARD.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."¹⁰

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."¹¹

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'¹²

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."¹³

9 Haines v. Quigg, 5 USPQ2d 1130 (N.D. Ind. 1987), 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

10 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

11 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

12 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

13 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

RELEVANT PORTIONS OF THE C.F.R.37 C.F.R. § 1.2 sets forth, *in toto*:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

37 C.F.R. § 1.113 sets forth, *in toto*:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. § 1.113 in a timely manner to the final Office action mailed March 4, 2004, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R. § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on June 5, 2004. A notice of abandonment was mailed on October 20, 2004.

On September 7, 2004, a continuation application was filed, claiming the benefit of the present application. Petitioner further included a three-month extension of time, a preliminary amendment, and remarks. This continuation application was assigned a serial number of 10/935,503.

ANALYSIS

With the present petition, Petitioner appears to be setting forth that he intended to submit a Request for Continued Examination (RCE), but submitted the wrong form: "it would appear that although there was a minor mistake with respect to the transmittal form used with filing the RCE application..."

Petitioner has met requirements (1) and (2) of Rule § 1.137(a). The fourth requirement is not applicable.

Regarding the third requirement, Petitioner has not established that the entire period of delay was unavoidable. It appears that Petitioner attempted to file an RCE, but filed a continuation application instead. **This is not a "minor mistake."** The RCE transmittal form, form PTO/SB/30 is what constitutes a Request for Continued Examination.

Additionally, the record strongly suggests that Petitioner intended to file a **continuation application, and not an RCE.** Petitioner submitted a "Utility Patent Application Transmittal" form, checked the box that indicates that the filing was a continuation of a prior-filed application, and identified the filing as a continuation of "prior application no. 09/356,771." Moreover, Petitioner submitted a "Fee Transmittal for FY 2003" form, and filled in "\$385.00" as the fee submitted for the

utility filing fee. It is noted that the field associated with the payment associated with the filing of an RCE was left blank. Additionally, it is noted that each of these forms was signed not by a secretary or a paralegal, but rather by the Petitioner, who is a registered practitioner.

Moreover, it is noted that **this application has been abandoned for an extended period of time.**

The notice of abandonment was mailed on October 20, 2004. More than two years later, the present petition was filed.

After receiving the notice of abandonment, it is not clear why the Applicant chose to take no course of action for such a long period of time. It does not appear that the Applicant took any action to further the prosecution of this application.

It is equally unclear what, after all of this time, prompted the Applicant to advance the prosecution of this application.

As such, it appears that the Applicant intentionally allowed this application to go abandoned.

The extended inaction of the Applicant appears to be intentional, and Petitioner does not appear to have submitted a statement of facts that would assert a contrary position.

A discussion follows.

In order for a petition under 37 C.F.R. § 1.137(a) to be granted, the holder of the rights to the application must have unintentionally allowed the application to go abandoned, and a delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unavoidable" delay within the meaning of 37 C.F.R. § 1.137(a).

The periods of delay:

There are three periods to be considered during the evaluation of a petition under 37 C.F.R. § 1.137(a):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 C.F.R. § 1.137(a) to have the holding of abandonment withdrawn or to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37

C.F.R. § 1.137(a) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (2) or (3).

Here, in view of the inordinate delay of more than two years (the period of time between the mailing of the notice of abandonment and the filing of the present petition to revive this application) in resuming prosecution, there is a question whether at least a portion of the entire delay was intentional.

On renewed petition, Petitioner must explain what effort(s) was made to further the prosecution of this application after receiving the notice of abandonment, and further, why no reply was filed for such an extended period of time. If no effort was made to reply, then Petitioner must explain why the delay in this application does not result from a deliberate course of action (or inaction). Statements are required from any and all persons having firsthand knowledge of the circumstances surrounding the lack of a timely response to the holding of abandonment. **As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action.** See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

Punctuality and Due Diligence:

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894).

Similarly, an invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App.

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D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

The lengthy period of inaction does not appear to be consistent with the requirements of punctuality, due diligence, good faith, and the encouragement of reasonable promptness.

On renewed petition, Petitioner will need to address each of these issues, if it is to be established that the entire period of delay was not intentional.

Petitioner is reminded that any statement of facts should be made by one having firsthand knowledge of the facts set forth therein.

Petitioner has referred to a telephonic discussion which purportedly took place with a member of the Office, however pursuant to Rule 37 C.F.R. § 1.2, "No attention can be "paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

Petitioner has further referred to **a plurality of status inquiries** that were purportedly submitted to the Office. **Written evidence which would substantiate this allegation should be provided to the Office on renewed petition.**

Pursuant to the discussion above, the petition is **DISMISSED**.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Thereafter, there will be no further reconsideration of this matter^{14, 15}.

14 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

15 If, on request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as a

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹⁶, hand-delivery¹⁷, or facsimile¹⁸.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. § 1.137(b).

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225¹⁹. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



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United States Patent and Trademark Office

final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

16 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

17 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

18 (571) 273-8300- please note this is a central facsimile number.

19 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).